

REMARKS

I. STATUS OF THE CLAIMS

Claims 1-76 are pending. Claims 10-14, 23-42, and 71-76 have been withdrawn from consideration as being drawn to a non-elected species. Claims 1-9, 15-22, and 43-70 have been rejected. Claim 9 has been amended to recite "A film-forming composition comprising" only once, rather than twice, in the preamble. Claim 38 has been amended to include the term "optionally" before the definition of monomer (d). These amendments were made at the suggestion of the Examiner and support for these amendments can be found throughout the specification and claims. Accordingly, no new matter has been added.

III. REJECTIONS UNDER 35 U.S.C. § 112

The Examiner rejects claims 1-9, 15-22, and 43-70 under 35 U.S.C. § 112, second paragraph as being indefinite for the reasons set forth on pages 3-4 of the Office Action. Applicants respectfully traverse each point of rejection as set forth below.

First, claims 1-6, 9, and 70 are rejected because the Examiner deems the use of the phrase "minimum film-forming temperature (MFT)" as "confusing." Office Action at 3. The Examiner alleges that the "MFT of a composition depends on the monomeric units in the polymer, as well as the particle size of the polymer, and is also influenced by the presence of water, emulsifiers, and organic solvents that can act as plasticizers." *Id.* The Examiner concludes that that "[t]herefore, applicant's use of the MFT to define a polymer is inconsistent with the actual definition and properties of minimum film-forming temperatures," and that "the MFT (or even Tg-MFT) cannot define a polymer, where the

MFT actually depends on a variety of factors and components independent of the polymer." *Id.*

When determining a claim's definiteness in compliance with 35 U.S.C. § 112, second paragraph, the Examiner's focus should be whether the claim meets "the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." M.P.E.P. § 2173.02. The definiteness of claim language must be analyzed, not in a vacuum, but in light of (1) the content of the particular application disclosure, (2) the teachings of the prior art, and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See, e.g., In re Marosi, 710 F.2d 799, 218 U.S.P.Q. 289 (Fed. Cir. 1983). Moreover, it is a fundamental principle that applicants are their own lexicographers, and may define their invention using whatever claim terms they choose so long as the terms "are not used in ways that are contrary to accepted meanings in the art." M.P.E.P. § 2173.01.

Here, the Examiner has not shown that Applicants' use of "MFT," in light of the specification, affects the clarity and precision of the claims. The specification as-filed provides not only an industry standard definition of MFT, ("... MFT is the limit temperature beyond which an aqueous of polymer forms a crack-free film on drying ...") but also the parameters for determining the MFT ("in the absence of auxiliary film-forming agents and ... according to the conditions described in DIN 53787, the disclosure of which relating to the determination of the MFT is specifically incorporated by reference"). See specification at paragraph [017]. Applicants note that

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DIN 53787 has been cancelled and replaced by ISO 2115, a copy of which is enclosed for the Examiner's convenience.

Moreover, the Examiner has not shown that Applicants' use of MFT is contrary to the accepted meanings in the art. Indeed, an initial internet search has reinforced our use of MFT in the specification and claims. For example, the Rhopoint Instrumentation website provides several examples of uses for its instruments, including minimum film-forming temperature determinations of polymers. See the attached printout from <http://www.rhopointinstruments.com/mfftb.html>. The website defines the minimum film-forming temperature as "[t]he lowest temperature at which a water-borne latex, emulsion, or adhesive, will uniformly coalesce when laid on a substrate as a thin film." It further states that the "design of the RhopointTM Instrument is based directly on th[e] standard" for determining MFT, in particular, "([g]roved platen for DIN 53787)." Thus, this website demonstrates that determining the MFT of a polymer is not unusual or indefinite. In view of the above, this point of rejection should be withdrawn.

Second, the Examiner rejects claim 9 for the language "film-forming cosmetic composition comprising: a film-forming composition comprising," and rejects claim 38 as "being confusing due to the limitations on monomer (d)." Office Action at 4. Without acquiescing with the Examiner's rejections of claims 9 and 38, Applicants have adopted the Examiner's suggested amendments, thus rendering these points of rejection moot.

Therefore, for at least the foregoing reasons, Applicants respectfully request that the rejections under § 112, second paragraph be withdrawn.

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IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The Examiner rejects claims 1-9, 15-22, and 43-70 under 35 U.S.C. § 103(a) as being unpatentable over Mondet *et al.* (U.S. Patent No. 5,965,116) ("Mondet") for the reasons set forth at pages 5-6 of the Office Action. The Examiner characterizes the present invention as "drawn to a composition comprising a copolymer latex combined with two organic solvents." Office Action at 5. Next, the Examiner contends that "Mondet teaches cosmetic compositions comprising a copolymer comprising at least three different monomers and having glass transition temperatures greater than 15° Celsius." *Id.* The Examiner notes that "a polymer from the prior art that has the same chemical composition as claimed in the instant application necessarily has the same physical properties." *Id.* He further states that "[w]hile applicant [sic] claims organic solvents as additives in the instant claims, the same substances are alternately known as plasticizers in the prior art . . . [and] [w]hile Mondet does not disclose the boiling points of the plasticizers, the compounds taught by Mondet necessarily meet the claimed boiling points, since the actual compounds are the same as claimed" *Id.* The Examiner concludes that although that Mondet does not specifically disclose two plasticizers or the presently claimed weight percentages of each plasticizer or the polymer, it would have been obvious to one of ordinary skill in the art to have modified the compositions of Mondet by routine optimization of weight percentages. Office Action at 6. The Examiner's view is that because Mondet teaches cosmetic additives as conventional in nail lacquers, there is motivation for the modification. *Id.*

Applicants respectfully traverse the Examiner's arguments for at least the following reasons. As an initial matter, Applicants note that, in order to establish a

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prima facie case of obviousness, an Examiner must meet three basic criteria. First, the Examiner must demonstrate that there would have been some suggestion or motivation, either in the cited reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify a reference. Second, the Examiner must demonstrate that there would have been a reasonable expectation of success in making such a modification. Finally, the reference or references must teach or suggest all of the claim limitations. See M.P.E.P. § 2143.

Here, at least the first criterion has not been met. Specifically, no motivation exists in Mondet to combine an organic solvent with a molecular weight less than or equal to 200 and a boiling point ranging from 100°C to 300°C, an organic solvent with a molecular weight greater than 200 and a boiling point greater than or equal to 120°C, and a polymer as presently claimed. As noted above, the Examiner asserts that it “would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Mondet by routine optimization of weight percentages in order to benefit from the formulation of nail varnishes and lacquers.” Office Action at 6. However, such a broad and conclusory statement falls short of establishing a *prima facie* case of obviousness. In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001). Indeed, by talking about routine optimization, the Examiner attempts to skip over the initial required showing: of motivation to choose the presently claimed solvents and polymer from Mondet and to combine them. This is because the Examiner cannot make such a showing.

The present specification distinguishes between a “plasticizer” (organic solvent with molecular weight greater than 200) and a “coalescing agent” (organic solvents with

molecular weight less than or equal to 200). See specification at paragraphs [067] and [070]. Thus, the present application requires the presence of organic solvents within both weight ranges. Mondet provides no guidance for differentiating between and then choosing one of each type of solvent. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." In re Napier, 55 F.3d 610, 613 (Fed. Cir. 1995).

The requirement for a showing of motivation to modify demands that the Examiner point out an indication that such a modification would be desirable. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1994). Here, the Examiner's broad statement that routine optimization of weight percentages would have been obvious "in order to benefit from the formulation of nail varnishes and lacquers," does not provide the necessary showing of motivation to modify Mondet to obtain the presently claimed parameters for these ingredients. Office Action at 6.

More specifically, Mondet states that the compositions it discloses "can also optionally contain a plasticizer" in addition to other optional ingredients such as a water-soluble thermal initiator (Col. 3, lines 64-65) (emphasis added) and a neutralization agent (Col. 4, lines 7-12). However, according to Mondet, "[t]he presence of a plasticizer is not obligatory in order to adjust the lacquering power" Mondet, col. 4, lines 21-29. In other words, Mondet does not require the plasticizer (solvent), and further does not even remotely suggest choosing two different solvents in combination

with a polymer as claimed. Thus, the Examiner has not shown, nor does Mondet contain, the motivation to combine two different organic solvents as claimed with the polymer presently claimed.

For at least the foregoing reasons, Applicants respectfully request that the rejections under 35 U.S.C. § 103 be withdrawn.

V. CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.


If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to contact Applicant's undersigned counsel at (202) 408-4454.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 3, 2003

By: 
Thalia V. Warnement
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Enclosures:

- 1) ISO 2115, "Plastics -- Polymer dispersions -- Determination of white point temperature and minimum film-forming temperature."
- 2) Printout of <<http://www.rhopointinstruments.com/mfftb.html>>

APPENDIX

9. (Amended) A film-forming cosmetic composition comprising: [a film-forming cosmetic composition comprising:]

- at least one polymer in an aqueous dispersion, wherein said at least one polymer has a glass transition temperature (T_g) ranging from 35°C to 80°C and a minimum film-forming temperature (MFT) such that T_g - MFT >- 8°C; and

- at least two organic solvents wherein:

- a first organic solvent has a molecular weight less than or equal to 200 and a boiling point, measured at ambient pressure, ranging from 100°C and 300°C, and
 - a second organic solvent has a molecular weight greater than 200 and a boiling point, measured at ambient pressure, greater than or equal to 120°C.

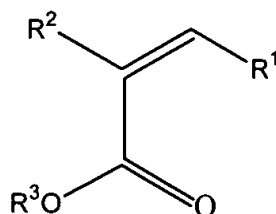
38. (Amended) A film-forming cosmetic composition according to Claim 27, wherein said at least one polymer is formed from:

-- a first polymer formed from:

- (a) at least one monomer (i) comprising at least one group chosen from ionic groups and ion-forming groups, wherein said at least one monomer (i) is present in an amount ranging from 5 to 40 parts by weight relative to the total weight of monomer forming said first polymer,
- (b) at least one monomer chosen from monomers of formula (1):

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(I)

wherein R¹ and R² which may be identical or different, are each chosen from hydrogen and methyl groups, and R³ is chosen from cyclic, linear, and branched (C₉-C₃₀) alkyl groups, wherein said at least one monomer chosen from monomers of formula (I) is present in an amount ranging from 2 to 50 parts by weight relative to the total weight of monomer forming said first polymer,

- (c) at least one neutral monomer (ii) chosen from (C₁-C₈)alkyl (meth)acrylates, vinyl esters of (C₁-C₁₈) carboxylic acids, and aromatic vinylic monomers, wherein said at least one neutral monomer (ii) is present in an amount ranging from 10 to 93 parts by weight relative to the total weight of monomer forming said first polymer, and
- (d) **optionally**, at least one additional monomer (d) differing from said at least one monomer (i), said at least one neutral monomer (ii) and said at least one monomer chosen from the monomers of formula (1), wherein said at least one monomer (d) is present in an amount ranging from 0 to 40 parts by weight relative to the total weight of monomer forming said first polymer, and

a second polymer formed from:

- (e) at least one neutral monomer (e) chosen from (C₁-C₈) alkyl (meth)acrylates, vinyl esters of (C₁-C₁₈) carboxylic acids, aromatic vinylic

monomers, wherein said at least one monomer (e) is present in an amount ranging from 60 to 100 parts by weight relative to the total weight of monomer forming said second polymer, and

- (f) at least one monomer (f) differing from said at least one neutral monomer (e), wherein said at least one monomer (f) is present in an amount ranging from 0 to 40 parts by weight relative to the total weight of monomer forming said second polymer.

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